

REMARKS

Claims 1-14 are presented for re-examination.

Claim 12 stands objected to as dependent on rejected claims, but was otherwise found allowable by the Examiner. Applicants have overcome the objection by rewriting Claim 12 in independent form.

Claim 1 has been amended to correct an editorial error wherein movement of the scan bar was erroneously characterized as being perpendicular to the longitudinal axis of the drum rather than parallel to that axis. Support for this change can be found in the drawings and the sentence on page 4 of the specification that states: "The rectangular metal structure is mounted on the translation rods and adapted for quick translational movement along the longitudinal axis which is parallel to axis 7".

Claims 1, 3-11, 13 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Goto in view of Chan. The rejection is respectively traversed.

According to the invention as defined in Claim 1, a plurality of scan modules are mounted on a scan bar that is movable axially along a rotatable drum. The Examiner notes that primary reference Goto discloses a scan module movable in that same direction, but notes that Goto shows but a single module. The Office Action suggests that it would have been obvious to provide Goto with a plurality of scan modules because secondary reference to Chan discloses plural scan modules. The rejection is traversed for the reasons set forth below.

There is no motivation within the prior art for the combination:

The Examiner appears to recognize that obviousness can only be established by combining references where there is some teaching, suggestion, or motivation to do so in the references themselves or in generally available knowledge. The Examiner's stated rationale for providing Goto with a plurality of scan modules is that the scan time of Goto would be reduced by using a plurality of scan modules as taught by Chan.

However, Chan does not suggest that using plural scan modules would in any way reduce the scan time. Rather, Chan addresses the problem of increasing the signal-to-noise ratio achievable with a single light collector. Scan time is not improved with the Chan device since the scan time of a single line is

limited by the time that it takes for the beam from single laser source 16 to traverse the entire length of slot 20.

Applicants propose that the test for motivation is not merely that the combination would be an improvement over the primary reference, but that there was some explicit teaching or suggestion in art to motivate one of ordinary skill to combine elements so as to create same invention. This is even supported by the two court cases cited by the Examiner. *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992), requires that the Examiner identify where the prior art provides a motivating suggestion for the modification. The Court held "Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so ... *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ.2d 1596, 1598-99 (Fed. Cir. 1988). "[at 1943]. "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound. "[at 1944].

Moreover, the Courts have uniformly held that a modification is not obvious unless the prior art suggests the desirability for the modification, as for example, in the decision in *In re Fritch*, 922 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992), where the Court held:

"The mere fact that prior art may be modified to reflect features of claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is **suggested by prior art** ... "[at 1780] (Emphasis added)
"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious **unless the prior art suggested the desirability of the modification**. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127.
"[at 1783] (Emphasis added)

Applicants believe that the motivational test applied by the Examiner is incorrect, and that there is no motivation to one skilled in the art to modify the subject matter of Goto in view of the teachings of Chan. In the present application, it is not the prior art that suggests that combining Goto and Chan "would decrease the time to scan an image" as suggested by the Examiner; but rather it is the specification of the present application that provides such teaching. "It is impermissible to use the claimed invention as an instruction

manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, Supra.

The combination would render the primary reference inoperative:

Note that both Goto and Chan have a single laser source whose beam addresses each pixel along the scan line. If Goto were modified as suggested by the Examiner to provide multiple photodetectors 20, the first photodetector would block the laser beam from reaching the remaining photodetectors, and render the apparatus inoperable. There is no suggestion in either reference to provide multiple laser sources.

The references in combination do not disclose the claimed invention:

Assuming arguendo that Goto and Chan might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. Goto discloses a single photodetector that, in Fig. 8, scans along the length of the drum to read an entire scan line. On the other hand, Chan does away totally with the need to move the photodetector by providing a plurality of photodetectors along the entire scan line. If the combination were made to provide Goto with the plurality of photodetectors that would be needed to cover the entire scan line, as taught by Chan, there would be no need to provide the movable scan bar and its translation drive as required by the claims of the present application. Thus, the references in the combination suggested by the Examiner would not teach the claimed invention.

Summary:

Claims 2-11, 13 and 14 depend from Claim 1 are allowable for at least the reasons set forth above. Accordingly, Applicants propose that the present claims define subject matter not taught or rendered obvious by the references of record. Reconsideration and favorable action are respectfully solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.